



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,844	02/10/2006	Manfred Kieser	MERCK-3135	7151
23599	7590	01/09/2007	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/09/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/567,844	KIESER ET AL.	
	Examiner Patrick D. Niland	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2/06</u> .	6) <input type="checkbox"/> Other: _____.

1. Claims 5-6 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the disclosed “derivatives”, does not reasonably provide enablement for all of the “derivatives” encompassed by the instant claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

A. The instant claims recite “derivatives” but the specification does not fully enable the full scope of “derivatives”. It is unclear how much derivation may be performed also. *In re Wands* has 8 criteria, MPEP 2164.01(a), as shown below.

(A)The breadth of the claims;
(B)The nature of the invention;
(C)The state of the prior art;
(D)The level of one of ordinary skill;
(E)The level of predictability in the art;
(F)The amount of direction provided by the inventor;
(G)The existence of working examples; and
(H)The quantity of experimentation needed to make or use the invention based on the content of the disclosure. The claimed “derivatives” encompass an infinite number of derivations (*Wands* factor A). The chemical arts are unpredictable to the ordinary skilled artisan (*Wands* factors B, C, D, and E). The ordinary skilled artisan has not even contemplated all of the “derivatives” encompassed by the instant claims nor figured out how to make them (*Wands* factors A-E). The instant specification gives scant direction as to how to make all of the “derivatives” encompassed by the instant claims and how to choose the ones that will function according to the instantly claimed

invention (Wands factors F-G). It would require an undue, e.g. infinite, amount of experimentation to determine how to make all of the “derivatives” encompassed by the instant claims and then to figure out which ones will function according to the instantly claimed invention (Wands factor H). The claims are therefore not commensurate in scope with the enabling specification.

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 16 provides for the use of the claimed pigment composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 16 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 and 9-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6451102 Hilder et al..

Hilder discloses a pigment composition containing pigments falling within the scope of the instantly claimed flake form effect pigments and the instantly claimed at least partially polar carrier material at the abstract; column 1, lines 1-67, particularly 6, 12, and 20-26; column 2, lines 1-67, particularly 8-19, 26-29 of which the montan ester and amide waxes are partially polar, and 30-47; column 3, lines 1-67, particularly 5-14 and 54-67 of which the extruder action will input mechanical energy which turns to heat to heat the composition of the patentee; column 4, lines 1-67, particularly 1-11; column 5, lines 1-40, particularly 7-9 and 18-21; and column 6, lines 1-38, particularly 19, 21, and 36-38 which falls within the scope of the additives of the instant claims. The patentee references melt flow of the compositions, which falls within the scope of the instant claims 11 and 13-14 given the melting point of the waxes of the patentee. The montan ester waxes are mixtures of waxes of the instant claims 2, 5 and 12.

5. Claims 1-5 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6451102 Hilder et al..

Hilder discloses a pigment composition containing pigments falling within the scope of the instantly claimed flake form effect pigments and the instantly claimed at least partially polar carrier material at the abstract; column 1, lines 1-67, particularly 6, 12, and 20-26; column 2, lines 1-67, particularly 8-19, 26-29 of which the montan ester and amide waxes are partially polar, and 30-47; column 3, lines 1-67, particularly 5-14 and 54-67 of which the extruder action will input mechanical energy which turns to heat to heat the composition of the patentee; column 4, lines 1-67, particularly 1-11; column 5, lines 1-40, particularly 7-9 and 18-21; and column 6, lines 1-38, particularly 19, 21, and 36-38 which falls within the scope of the additives of the instant claims. The patentee references melt flow of the compositions, which falls within the

scope of the instant claims 11 and 13-14 given the melting point of the waxes of the patentee. The montan ester waxes are mixtures of waxes of the instant claims 2, 5 and 12.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed processing parameters, i.e. adding heat to give the claimed temperatures, with the montanate and amide waxes of the patentee to obtain the melt flow and easier mixing due to the lower viscosity of molten products referenced regarding the heated polyethylene compositions of the patentee and because the combinations of montanate or amide waxes with the disclosed pigments would have been expected to give the improvements taught by the patentee.

6. Claims 1-7 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 03/035745 A1 Richter et al., as translated by US Pat. Application Pub. No. 2004/0254280 A1 Richter et al. in combination with US Pat. No. 6451102 Hilder et al..

Hilder discloses a pigment composition containing pigments falling within the scope of the instantly claimed flake form effect pigments and the instantly claimed at least partially polar carrier material at the abstract; column 1, lines 1-67, particularly 6, 12, and 20-26; column 2, lines 1-67, particularly 8-19, 26-29 of which the montan ester and amide waxes are partially polar, and 30-47; column 3, lines 1-67, particularly 5-14 and 54-67 of which the extruder action will input mechanical energy which turns to heat to heat the composition of the patentee; column 4, lines 1-67, particularly 1-11; column 5, lines 1-40, particularly 7-9 and 18-21; and column 6, lines 1-38, particularly 19, 21, and 36-38 which falls within the scope of the additives of the instant claims. The patentee references melt flow of the compositions, which falls within the

scope of the instant claims 11 and 13-14 given the melting point of the waxes of the patentee. The montan ester waxes are mixtures of waxes of the instant claims 2, 5 and 12.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed mixture of polyamide wax and montan waxes in the amounts of the instant claim 6 as the wax mixture with the effect pigments of Hilder because Richter shows the benefits of using the instantly claimed mixtures of waxes at sections [0001]-[0006], [0010]-[0013], [0016]-[0046], [0047]-[0049], [0056], particularly the amounts of ingredients, and the remainder of the document and these benefits would have been expected with the pigment compositions of Hilder. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed flake form effect pigments as the pigments of Richter because they are known for use in similar compositions such as those taught by Hilder and the effect pigment benefits would have been expected in the pigments disclosed by Richter generically. The compound of Richter's claim 11 is a polyamide copolymer which falls within the scope of the instant claim 7

7. Claims 1-4, 7-10, 13, and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2002-309150 A Rock Paint KK.

Rock Paint discloses mixing effect pigments with ethylene vinyl acetate or ethylene acrylic acid having melting points within the scope of the instant claim 4 at the DETAILED DESCRIPTION, sections [0002], of which the mica based effect pigments are necessarily in flake form, [0006], [0008], [0009], [0011], [0013]-[0024] in particular.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free),



Patrick D. Niland
Primary Examiner
Art Unit 1714